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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/978,131	10/16/2001	T. Paul Smith		3792

7590 06/27/2003

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EXAMINER

LEWIS, AARON J

ART UNIT	PAPER NUMBER
	3761

DATE MAILED: 06/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/978,131	SMITH ET AL.
	Examiner	Art Unit
	AARON J. LEWIS	3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 16 October 2001.
  - 2a) This action is FINAL.                    2b) This action is non-final.
  - 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.
- Disposition of Claims**
- 4) Claim(s) 1-12 is/are pending in the application.
    - 4a) Of the above claim(s) 1-7 is/are withdrawn from consideration.
  - 5) Claim(s) \_\_\_\_\_ is/are allowed.
  - 6) Claim(s) 8-12 is/are rejected.
  - 7) Claim(s) \_\_\_\_\_ is/are objected to.
  - 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a)  The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                   | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)          | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. | 6) <input type="checkbox"/> Other: _____                                    |

***Election/Restrictions***

1. Applicant's election with traverse of Group III in Paper No. 05 is acknowledged.

The traversal is on the ground(s) that the claimed process cannot be used to make impermeable solid rods. This is not found persuasive because the process of blown film extrusion is employed to make materials having a variety of shapes including webs, rods, and tubes.

The requirement is still deemed proper and is therefore made FINAL.

***Claim Objections***

2. Claims 8 and 9 are objected to because of the following informalities: In line 1 of claim 8, "...patent..." should read --patient--. In line 5 of claim 9, there is a period after the second recitation of "...fitting..." but before "...end..." (a claim is required to be a single sentence). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 9 recites the limitations "...said tubing shrink fit..." in line 4; "...said shrink fit portion..." in line 5; "...said expanded portion..." in line 6. There is insufficient antecedent basis for these limitations in the claim.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Jackson ('796).

As to claim 8, Jackson (figs.1-3) discloses a dryer or humidifier for patient breathing lines comprising, a thin walled permeable membrane tubing (#18 and col.3, lines 2-10); an inner mesh (52) mounted within said tubing to support said tubing; and outer mesh (50) surrounding the exterior of said tubing to protect said tubing; and connector means (24,24') attached to said tubing for connecting said tubing in patient breathing lines (fig.1).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 9,10,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson ('796) in view of Kertzman ('201).

As to claim 9, Jackson (figs.1-3) discloses a dryer or humidifier for patient breathing lines comprising, a thin walled permeable membrane tubing (#18 and col.3, lines 2-10); an inner mesh (52) mounted within said tubing to support said tubing; an outer mesh (50) surrounding the exterior of said tubing to protect said tubing; and at least one end fitting (24,24') affixed to said tubing.

The difference between Jackson and claim 9 is the fitting affixed to said tubing using a shrinkable material.

Kertzman, in a dryer or humidifier for patient breathing lines (col.1, lines 39-41), teaches affixing a fitting to permeable membrane tubing using a shrinkable material (31,33) for the purpose of providing a seal which resists failure under conditions of expansion/contraction, sterilization and chemical exposure (col.4, lines 50-56 and col.5, lines 15-18).

It would have been obvious to modify the manner of attachment of the fittings in Jackson to employ a shrinkable material because it would have provided a seal between the permeable membrane tubing and connector which resists failure under conditions of expansion/contraction, sterilization and chemical exposure as taught by Kertzman.

As to claim 10, the inside diameter of the outer mesh is larger than the outside diameter of said tubing in Jackson. That is, the outer mesh is expressly disclosed as a wire mesh jacket which reinforces the tube by surrounding its outer surface. This outer mesh merely surrounds the outer surface of the tube, it is not fused along the entire outer surface of the tube; consequently, the inner diameter of the mesh is larger than the outer diameter of the membrane tube.

As to claim 12, Jackson as modified by Kertzman as discussed above with respect to claim 9, also teaches the permeable membrane tubing formed by blown film extrusion (col.1, line 28 and col.2, line 12 of Kertzman). MPEP 2113 states "Even though product-by-process claims are limited by and defined by the process, determination of

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patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." Consequently, the process recitation of the tube being formed by blown film extrusion in claim 12 is noted but not structurally distinguishing.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jackson in view of Kertzman as applied to claims 9,10,12 above, and further in view of Gadsden et al. ('904)

The difference between Jackson as modified by Kertzman and claim 11 is an adhesive lining in the heat shrink material.

Gadsden et al. teach an adhesive lining (2) in combination with a heat shrink material for permanently bonding tubular members together (col.7, line 55-col.8, line 7).

It would have been obvious to further modify the heat shrink material of Jackson as modified by Kertzman to include an adhesive material in combination with the heat shrink material because it would have provided a permanent bond as taught by Gasden et al..

### ***Conclusion***

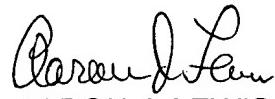
10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The balance of the art is cited to show relevant permeable membrane tubes.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to AARON J. LEWIS whose telephone number is (703) 308-0716. The examiner can normally be reached on 9:30AM-6:00PM M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WEILUN LO can be reached on (703) 308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3590 for regular communications and (703) 305-3590 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

  
AARON J. LEWIS  
Primary Examiner  
Art Unit 3761

Aaron J. Lewis  
June 20, 2003